

Remarks

Claims 16, 18-20 and 24-31 are pending and are rejected under 35 U.S.C. § 103(a). Claim 16 is provisionally rejected on the ground of non-statutory obviousness-type double patenting. Applicants thank Examiners Towa for participating in the Examiner Interview of June 2, 2011 with Applicants' attorney during which the distinctions between the claimed invention and the prior art references were discussed. Claims 16 and 29 have been amended. Support for the amendments can be found, at least at, page 6, lines 17-21 of the originally-filed Specification. For the reasons stated below, Applicant respectfully requests reconsideration and withdrawal of the rejections to the claims.

1. **DOUBLE PATENTING**

The Office action states claim 16 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claim 13 of copending Application No. 12/393,931. If appropriate, Applicants will submit a terminal disclaimer when the claims of this application have been allowed. Applicants respectfully request this rejection be held in abeyance until the claims have been allowed.

2. **REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)**

Claims 16, 18-20 and 25-31 stand rejected under 35 U.S.C. § 103(a)

Claims 16, 18-20 and 25-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,392,779 to Meredith et al. ("Meredith") in view of U.S. Patent No. 4,511,330 to Smiley et al. ("Smiley") and further in view of U.S. Patent No. 6,161,046 by Maniglia et al. ("Maniglia"). For a rejection to be proper under 35 U.S.C. § 103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention. For the reasons stated below, Applicant respectfully submits that Meredith, Smiley and Maniglia, either alone or in combination, do not teach or suggest every element of Applicant's claimed invention.

Regarding claims 16, 18-20, 25-31

Claim 16 recites, in part:

“a testing apparatus comprising an electromagnetic field generator for exciting the member and comprising detecting means for detecting a fundamental resonance frequency of the member when it is attached to the implant” and “wherein said member comprises a magnetic part and said testing apparatus detecting means comprises an electromagnetic detector for contactless detection of said magnetic part.”

Applicants submit Maniglia, Smiley and Meredith do not teach these elements of the claimed invention. The Office action states Maniglia teaches a “disposable implant member 36’ comprising a magnetic detectable part having a (titanium) coil releasably connected to a bone 24’; and a probe portion comprising an electromagnetic detector (i.e., coil) (see fig. 4; col. 5, lines 45-49; col. 6, lines 8-10, 13-16 & 51-57.”) (Note: the Office action states Meredith lacks a member comprising a magnetic part or a coil; or a detector comprising an electromagnetic part of a magnetic part). Applicants respectfully submit neither Smiley nor Maniglia remedy the deficiencies of Meredith. Neither Smiley nor Maniglia teach exciting a member attached to an implant to bring the member into vibration. In addition, neither Smiley nor Maniglia describe any motivation or benefit for exciting a member attached to an attachment to a bone (e.g., dental implant attached to a bone). Maniglia teaches (and the components identified in the Office action are components of) a microphone, as explained in Applicants previous response. Maniglia does not teach magnetically exciting a member attached to the implant, and wherein an electromagnetic detector contactlessly detects at least one resonance frequency of the magnetic part attached to the implant. Smiley also does not cure the deficiencies of Meredith and Maniglia. Smiley discloses a therapeutic method for aligning a patient’s jaw structure with opposing magnets. Smiley also does not disclose magnetically exciting the member as required by the claims.

In addition, neither Maniglia nor Smiley teach detecting means for detecting a fundamental resonance frequency of the member when it is attached to the implant. The microphone of Maniglia is configured for responding to auditory vibrations. (see, Maniglia, Abstract). Further, Meredith, Smiley and Maniglia do not teach or suggest that the microphone

of Maniglia or the magnetic therapeutic device of Smiley could be used for such purposes. In addition, Applicants submit it would not have been obvious to one of ordinary skill in the art to combine (nor is there a motivation to combine) the teachings of Meredith, Smiley and Maniglia. Applicants also submit the references do not teach or suggest how the elements of Meredith could be combined with the elements of Smiley and Maniglia to achieve the desired result. Accordingly, Applicants respectfully submit Meredith, Smiley and Maniglia, either alone or in combination, do not teach or suggest every element of Applicant's claimed invention.

For, at least, the reasons stated above, Applicants submit that claim 16 is in condition for allowance. Claims 18-20, 25-28, and 30-31 depend, directly or indirectly, from claim 16. For the same reasons as stated above with respect to claim 16, Applicants submit claims 18-20, 25-28, and 30-31 also are in condition for allowance.

Regarding claim 29

Claim 29 recites:

“A disposable implant testing part provided for testing an implant attached to a bone, said part comprising a detectable part, which can be excited by a electromagnetic field generator of the testing apparatus and wherein a fundamental resonance frequency can be detected contactlessly by a detector of the testing apparatus.”

Applicants submit Meredith, Maniglia and Smiley do not teach or suggest the elements of claim 29 for the same reasons described above with respect to claim 16. Accordingly, Applicants submit that claim 29 is in condition for allowance.

Claim 24 stands rejected under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meredith as modified by Smiley and Maniglia, and further in view of U.S. Patent No. 6,583,630 to Mendes et al. (“Mendes”). For a rejection to be proper under 35 U.S.C. §103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention.

For the reasons stated below, Applicant respectfully submits that Meredith, Smiley, Maniglia and Mendes, alone or in combination, do not teach or suggest every element of Applicant's claimed invention.

The Office action states that Mendes describes a detectable part that consists of ferromagnetic material. Applicants submit that Mendes does not cure the deficiencies of Meredith, Smiley and Maniglia. Applicants submit that Mendes does not teach or suggest, at least the following limitations of claim 16:

“a member adapted to be releasably attached to said implant; and
a testing apparatus comprising an electromagnetic field generator for exciting the
member and comprising detecting means for detecting a fundamental resonance
frequency of the member when it is attached to the implant,
wherein said member comprises a magnetic part and said testing apparatus detecting
means comprises an electromagnetic detector for contactless detection of said
magnetic part.”

For the reasons stated above, Applicants submit claim 24 is in condition for allowance.

CONCLUSION

Applicant's discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant's emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable nor does it imply the claims were not allowable in their unamended form.

In view of the foregoing remarks, Applicants respectfully submit that all claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner feels that a telephone conference would expedite the prosecution of this case, the Examiner is invited to call the undersigned.

If any fees are due with the submission of this Amendment and Response, the Commissioner is hereby authorized to charge the fees due to Attorney's Deposit Account No. 50-4514.

Respectfully submitted,

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